

Application No. 10/825,531

Reply to Office Action

REMARKS/ARGUMENTS

*The Pending Claims*RECEIVED
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Claims 19-45 are pending and directed to a compound (claims 19 and 20), a composition (claims 21 and 22), a method of inhibiting CETP activity in a patient (claims 23, 24, and 31), a method of increasing HDL in a patient (claims 25, 26, and 32), a method of treating or preventing atherosclerosis in a patient (claims 27, 28, and 33), a method of treating or preventing hyperlipidemia in a patient (claims 29, 30, and 34), and methods of preparing a compound of formula (1) (claims 35-45).

Amendments to the Claims

Claims 1-18 have been canceled. Claims 19-45 are new and are supported by the specification as a whole. Specifically, claims 19-22 are supported by the specification at, for example, page 1, first paragraph; the paragraph bridging pages 46 and 47; page 47, fourth paragraph; page 61; and Example 10. Claims 23-34 are supported by the specification at, for example, page 1, first paragraph; page 6, third paragraph; and the paragraph bridging pages 47 and 48. Claims 35-45 are supported by the specification at, for example, page 1 and the chemical scheme on page 48 and page 50. No new matter has been added by way of these amendments.

Information Disclosure Statement

Applicants thank the Examiner for returning the initialed PTO-1449 form from the Information Disclosure Statement submitted on April 15, 2004. Reference AV (i.e., JP 47-35786) was crossed out by the Examiner, since a copy of the abstract could not be located in the parent application. Applicants hereby submit a courtesy copy of the abstract for Reference AV so that the Examiner can consider the reference and return to Applicants a copy of the PTO-1449 form acknowledging consideration of Reference AV. Applicants note that JP 47-35786 is the publication number of patent application number JP 43-052626. The publication and application numbers are also written as JP 72035786 and JP 196852626, respectively.

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Summary of the Office Action

The Office has maintained the restriction requirement between Groups I and II but has withdrawn the species election requirement.

Claims 1-15 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by various references.

The Office has rejected claims 1-4, 6-9, and 11-14 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-7 of U.S. Patent 6,753,346.

Claims 1-15 also have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claim 5 of U.S. Patent 6,426,365.

Reconsideration of the rejections in view of the new claims is hereby requested.

Discussion of the Claim Objections and Anticipation Rejections

Claims 1-18 have been canceled. Accordingly, the objections to canceled claims 1-18 are moot and should be withdrawn. New claims 19-45 are directed to specific compounds, namely N-(2-mercaptophenyl)-1-(2-ethylbutyl)cyclohexanecarboxamide or a pharmaceutically acceptable salt, hydrate, or solvate thereof, compositions containing the compounds, and methods of using the compound therapeutically and synthetically.

With respect to the restriction requirement, restriction between claims 19-45 is not proper since the claims are interrelated between a compound, composition comprising the compound, and methods of using the compound. Thus, the nature of the claims is such that there would not be a serious burden placed on the Examiner in searching all of the pending claims together. For example, any search and consideration of the compound of claims 19 and 20 will necessarily overlap the search and consideration of the subject matter of the composition claims (i.e., claims 21 and 22), method of use claims (i.e., claims 23-34), and synthesis method claims (i.e., claims 35-45).

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Regarding the anticipation rejections, the references cited by the Office do not teach the compounds, compositions, methods of use, or synthetic methods recited in new claims 19-45, and, therefore, the anticipation rejections are inapplicable to the new claims.

Discussion of Obviousness-Type Double Patenting Rejection

To advance prosecution of the instant application, Applicants submit herewith a terminal disclaimer in view of U.S. Patent 6,426,365. Accordingly, the obviousness-type double patenting rejection over U.S. Patent 6,426,365 should be withdrawn.

In view of the amended claims, the obviousness-type double patenting rejection over U.S. Patent 6,753,346 ("the '346 patent") is moot. The claims of the '346 patent do not teach or suggest the compound of pending claims 19-34. With respect to pending claims 35-45, the claims of the '346 patent do disclose a compound of formula (1); however, none of the claims of the '346 patent teach or suggest any methods of synthesizing the compound, let alone using N-(2-mercaptophenyl)-1-(2-ethylbutyl)cyclohexanecarboxamide as a starting material. Without the benefit of the '346 patent specification as guidance, one of ordinary skill in the art would not be led to the specific synthesis methods of pending claims 35-45. Therefore, this rejection should be withdrawn.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,


John Kilyk, Jr., Reg. No. 30,763
LEBYDIG, VOIT & MAYER, LTD.
Two Prudential Plaza, Suite 4900
180 North Stetson Avenue
Chicago, Illinois 60601-6780
(312) 616-5600 (telephone)
(312) 616-5700 (facsimile)

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